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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,511	02/20/2002	Holger Bengs	29988/AX98148	4099

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EXAMINER

TRAVERS, RUSSELL S

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,511

Applicant(s)

BENGs ET AL.

Examiner

Russell Travers, J.D., Ph.D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,6,8-12,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8-12 and 14-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The amendment filed May 17, 2004 has been received and entered into the file.

Applicant's arguments filed May 17, 2004 have been fully considered but they are not deemed to be persuasive.

Claims 1, 6, 8-12 and 14-15 are presented for examination.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1, 6, 8-10 and 14-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Kossmann et al.

Kossmann et al teach the herein claimed amylose compounds as old and well known in combination with various pharmaceutical carriers and excipients in a dosage

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form. These medicaments are taught as useful for producing various films (see page 1, paragraph 2). Claims 1, 6, 8-10 and 14-15, and the primary reference, differ as to:

- 1) recitation of specific solubility levels, and
- 2) intended use.

The instant claims are directed to employing a biochemical process for obtaining an old and well known compound. Arguments that Applicant's claims are not directed to the old and well known ultimate compound are not probative. It is well settled patent law that a product by process reads on the product. In the instant case Examiner need not reach this ruling. Attention is directed to Kossmann et al, page 25, paragraph 2, setting forth the synthesis of insoluble amylose by employing various immobilized enzymes. These compounds are taught as "insoluble linear glucans", which "can be easily purified further", motivating the skilled artisan to obtain extremely homogeneous compounds. Examiner notes a compound and those properties possessed by such compounds are inseparable, thus, a compound taught by the prior art as possessing various properties would meet specific criteria, absent of a recitation of such specific properties. Possessing these teachings the skilled artisan would have seen the production of the claimed amylose, possessing the required physical characteristics, as residing in the skilled artisan's possession.

Applicant's attention is drawn to In re Dillon, 16 USPQ2nd 1897 at 1900 (CAFC 1990). The court sitting in banc ruled that the recitation of a new utility for an old and well known composition does not render that composition new.

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Claims 11 and 12 are rejected under 35 U.S.C. § 103 as being unpatentable over Kossmann et al, as set forth above, in view of Ikeda et al and Schneider et al.

Ikeda et al teach the claimed various in soluble starch compounds as old and well known in combination with various pharmaceutical carriers and excipients in lipstick and cosmetic formulations (see table 11). These excipients and carriers are taught as useful for producing various cosmetic films, as herein claimed. Schneider et al teaches those linear amylose compounds as herein claimed as old and well known powder excipients useful for general formulation, as herein claimed. Claims 11 and 12, and the primary references, differ as to:

- 1) recitation of specific solubility levels, and
- 2) intended use.

The instant claims are directed to employing a biochemical process for obtaining an old and well known compound. Arguments that Applicant's claims are not directed to the old and well known ultimate compound are not probative. It is well settled patent law that a product by process reads on the product. In the instant case Examiner need not reach this ruling. Attention is directed to Schneider et al (see claims 1-6), setting forth the synthesis of insoluble amylose useful for formulating any useful product requiring starch powder. Possessing these teachings the skilled artisan would have seen the production of the claimed amylose as residing in the skilled artisan's possession.

Applicant's attention is drawn to In re Dillon, 16 USPQ2nd 1897 at 1900 (CAFC 1990). The court sitting in banc ruled that the recitation of a new utility for an old and well known composition does not render that composition new.

No claims are allowed.

RESPONSE TO ARGUMENTS

As stated above, Applicant's attention is drawn to In re Dillon, 16 USPQ2nd 1897 at 1900 (CAFC 1990). The court sitting in banc ruled that the recitation of a new utility for an old and well known composition does not render that composition new. Thus, possessing a composition of matter, eth skilled artisan possesses this compound for any use, not simply those uses envisioned.

Attention is again directed to Kossmann et al, page 25, paragraph 2, setting forth the synthesis of insoluble amylose by employing various immobilized enzymes. These compounds are taught as "insoluble linear glucans", which "can be easily purified further", motivating the skilled artisan to obtain extremely homogeneous compounds. Examiner notes a compound and those properties possessed by such compounds are inseparable, thus, a compound taught by the prior art as possessing various properties would meet specific criteria, absent of a recitation of such specific properties. Possessing these teachings the skilled artisan would have seen the production of the claimed amylose, possessing the required physical characteristics, as residing in the skilled artisan's possession.

The instant claims are directed to an old and well known compound possessing a specific purity. Arguments that Applicant's claims are not directed to this old and well

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known compound are not probative. It is well settled patent law that recitation of properties inherently possessed by such compounds fails to impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.". Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter, may in fact be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various biochemical intermediates. The ultimate utility for the claimed compounds is old and well known, rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103.

Attention is directed to Kossmann et al (page 1, paragraph 2) teaching the instant amylose compounds as useful for producing non-toxic films, seen as indistinguishable from those compositions herein claimed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Travers, J.D.,Ph.D whose telephone number is 703-308-4603. The examiner can normally be reached on Monday to Thursday from 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-272-0631.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'RT', enclosed within a large, loopy oval stroke.

Russell Travers J.D., Ph.D.
Primary Examiner
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